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Deanna T. Ongwela
9231 Redbridge Court
Laurel, MD 20723

#90

8/14/02

In re Patent Application Serial Number: :
09/665,608 :
Filed: September 20, 2000 :
For: Massage and Tactile Stimulation :
Device :
Date: August 14, 2002 (:
:

Dear Mrs. Ongwela:

This communication is responsive to your faxed letter dated August 8, 2002 in connection with the above-identified application. In your communication, you have discussed your perceived difficulties in receiving guidance in the prosecution of your application and have accordingly requested that any necessary fees in conjunction with the filing of a continuation application be waived.

I have reviewed your application and considered your request. The Office Actions prepared by Examiner Yu were thorough and complete, properly addressing the features of your claimed invention as well as addressing any arguments you asserted regarding patentability of your claimed invention. While your comments express the belief that lack of guidance resulted in your inability to present allowable claims, my review indicates that you did receive proper guidance in the procedural aspects of filing your responses. Indeed, you were contacted upon receipt of your initial amendment and given the opportunity to correct any informalities presented in your response without penalty. Mr. Crow then reviewed your proposed response to the final Office Action to provide guidance on the process for responding to a final Office Action. However, prosecution of your application has concluded in a difference of opinion regarding the presence of allowable subject matter in this application. While your proposed amendments after Final Rejection may define over **one** prior art U.S. patent (Lohati et al.), these proposed amendments do not render the claims patentable and thus were properly denied entry after Final Rejection.


Your request to waive any necessary fees in conjunction with the filing of a continuation application is denied. Please be advised that you have two options to pursue patenting of your claimed invention (neither of which would necessarily result in the patenting of your claimed invention):

(1) the filing of a 3 month extension of time fee (\$460 for a small entity) on, or prior to, September 22 (2 month small entity extension fee of \$200 if filed on or before **August 22**), coupled with the filing of a continuation application and its associated fee (\$370 for a small entity) to continue prosecution of the claims before the examiner; or

(2) the filing of a 3 month extension of time fee (\$460 for a small entity) on, or prior to, September 22 (2 month small entity extension fee of \$200 if filed on or before **August 22**), coupled with the filing of a Notice of Appeal and its associated fee (\$160 for a small entity) indicating your intent to appeal the final decision of the examiner before the Board of Patent Appeals and Interferences. An Appellant's Brief on Appeal and its associated \$160 small entity fee would then need to be filed within 2 months of the filing of the Notice of Appeal.

Please note that your selection of option (2) would result in the appeal of the claims present at the time of the Final Rejection, not an appeal of your proposed amendments subsequent to Final Rejection.

Should you have any further questions or concerns regarding this application or any other matter, please feel free to contact me at 703-308-0873.



John E. Kittle

Director, Technology Center 3700/2900

Attachments: MPEP Sections 714.12 – 714.13 and 1205 - 1207

expense. Physical entry of the amendment will be made from the permanent copy.

If there is no appropriate reply within the 1-month limit, a copy is made by the Patent and Trademark Office, applicant being notified and required to remit the charges or authorize charging them to his or her deposit account.

In the second instance, when the nonpermanence of the amendment is discovered only when the application is reached for action, similar steps are taken, but action on the application is not held up, the requirement for a permanent copy of the amendment being included in the Office action.

A good direct or indirect copy, such as photocopy or facsimile transmission, on satisfactory paper is acceptable. But see *In re Application Papers Filed Jan. 20, 1956*, 706 O.G. 4 (Comm'r Pat. 1956). Although a good copy is acceptable, signatures must be applied after the copy is made if the papers require an original signature as set forth in 37 CFR 1.4(e).

See MPEP § 608.01 for more discussion on acceptable copies.

714.08 Telegraphic Amendment

When a telegraphic amendment is received, the telegram is placed in the file but not entered. Applicant will be notified that the telegram is not accepted as a reply to the previous Office action and is not entered. The time period for reply to the Office action continues to run and is extendable under 37 CFR 1.136.

714.09 Amendments Before First Office Action

An amendment filed before the first Office action, but not filed along with the original application, does not enjoy the status of part of the original disclosure. See MPEP § 608.04(b). However, an application will be accorded a filing date based upon the submission of a complete specification including claims and any required drawings. The oath or declaration and/or filing fee can be submitted later. Thus, in the instance where an application filed under 37 CFR 1.53(b) is filed without a signed oath or declaration and such application is accompanied by an amendment, that amendment is considered a part of the original disclosure. A subsequently filed oath or declaration must refer to both the application and the amendment. Any copy of the application as filed must include a copy of the amendment as well, particularly where certified copies for priority purposes are requested.

Amendments should either accompany the application or be filed after the application has received its application number and filing date. See MPEP § 502.

Any amendment canceling claims in order to reduce the filing fee should be filed with the application. Since only

amendments canceling claims are entered before the filing fee is calculated, any other changes to the claims and/or specification should be part of a separate amendment. See MPEP § 506.

714.10 Claims Added in Excess of Filing Fee

The patent statute provides for the presentation of claims added in excess of the filing fee. On payment of an additional fee (see MPEP § 607), these excess claims may be presented any time after the application is filed, which of course, includes the time before the first action.

714.11 Amendment Filed During Interference Proceedings

See MPEP § 2364.01.

714.12 Amendments After Final Rejection or Action

37 CFR 1.116. Amendments after final action or appeal.

(a) After a final rejection or other final action (§ 1.113), amendments may be made cancelling claims or complying with any requirement of form expressly set forth in a previous Office action. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. The admission of, or refusal to admit, any amendment after final rejection, and any related proceedings, will not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135.

(b) If amendments touching the merits of the application or patent under reexamination are presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon showing of good and sufficient reasons why they are necessary and were not earlier presented.

(c) No amendment can be made as a matter of right in appealed cases. After decision on appeal, amendments can only be made as provided in § 1.198, or to carry into effect a recommendation under § 1.196.

Once a final rejection that is not premature has been entered in a case, applicant or patent owner no longer has any right to unrestricted further prosecution. This does not mean that no further amendment or argument will be considered. Any amendment that will place the case either in condition for allowance or in better form for appeal may be entered. Also, amendments complying with objections or requirements as to form are to be permitted after final action in accordance with 37 CFR 1.116(a). Ordinarily, amendments filed after the final action are not entered unless approved by the examiner. See MPEP § 706.07(f), § 714.13 and § 1207.

The prosecution of an application before the examiner should ordinarily be concluded with the final action. However, one personal interview by applicant may be entertained after such final action if circumstances warrant. Thus, only one request by applicant for a personal interview after final should be granted, but in exceptional

circumstances, a second personal interview may be initiated by the *examiner* if in his or her judgment this would materially assist in placing the application in condition for *allowance*.

Many of the difficulties encountered in the prosecution of patent applications after final rejection may be alleviated if each applicant includes, at the time of filing or no later than the first reply, claims varying from the broadest to which he or she believes he or she is entitled to the most detailed that he or she is willing to accept.

714.13 Amendments After Final Rejection or Action, Procedure Followed

FINAL REJECTION — TIME FOR REPLY

If an applicant initially replies within 2 months from the date of mailing of any final rejection setting a 3-month shortened statutory period for reply and the Office does not mail an advisory action until after the end of the 3-month shortened statutory period, the period for reply for purposes of determining the amount of any extension fee will be the date on which the Office mails the advisory action advising applicant of the status of the application, but in no event can the period extend beyond 6 months from the date of the final rejection. This procedure applies only to a first reply to a final rejection. The following language must be included by the examiner in each final rejection:

A SHORTENED STATUTORY PERIOD FOR REPLY TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST REPLY IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR REPLY EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

This wording is part of Form Paragraphs 7.39, 7.40, 7.40.01, 7.41 and 7.41.03. Form Paragraph 7.39 appears in MPEP § 706.07. Form paragraphs 7.40 and 7.40.01 appear in MPEP § 706.07(a). Form Paragraphs 7.41 and 7.41.03 appear in MPEP § 706.07(b).

For example, if applicant initially replies within 2 months from the date of mailing of a final rejection and the examiner mails an advisory action before the end of 3 months from the date of mailing of the final rejection, the shortened statutory period will expire at the end of 3 months from the date of mailing of the final rejection. In such a case, any extension fee would then be calculated

from the end of the 3-month period. If the examiner, however, does not mail an advisory action until after the end of 3 months, the shortened statutory period will expire on the date the examiner mails the advisory action and any extension fee may be calculated from that date. In the event that a first reply is not filed within 2 months of the mailing date of the final rejection, any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the end of the reply period set in the final rejection.

Failure to file a reply during the shortened statutory period results in abandonment of the application unless the time is extended under the provisions of 37 CFR 1.136.

ENTRY NOT A MATTER OF RIGHT

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate previously canceled claims.

Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under 37 CFR 1.116(b) is expected in all amendments after final rejection. Failure to properly reply under 37 CFR 1.113 to the final rejection results in abandonment. A reply under 37 CFR 1.113 is limited to: (A) an amendment complying with 37 CFR 1.116; or (B) a Notice of Appeal (and appeal fee). Further examination of the application, however, may be obtained by filing a continued prosecution application (CPA) under 37 CFR 1.53(d), if appropriate. See MPEP § 201.06(d).

An amendment filed at any time after final rejection but before an appeal brief is filed, may be entered upon or after filing of an appeal brief provided the total effect of the amendment is to (A) remove issues for appeal, and/or (B) adopt examiner suggestions.

See also MPEP § 1207 and § 1211.

The Patent and Trademark Office does not recognize "conditional" authorizations to charge an appeal fee if an amendment submitted after a final Office action is not entered. Any "conditional" authorization to charge an appeal fee set forth in 37 CFR 1.17(b) will be treated as an unconditional payment of the fee set forth in 37 CFR 1.17(b).

ACTION BY EXAMINER

See also MPEP § 706.07(f).

In the event that the proposed amendment does not place the case in better form for appeal, nor in condition for allowance, applicant should be promptly informed of this fact, whenever possible, within the statutory period. The refusal to enter the proposed amendment should not be

arbitrary. The proposed amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified. Ordinarily, the specific deficiencies of the amendment need not be discussed. The reasons for nonentry should be concisely expressed. For example:

(A) The claims, if amended as proposed, would not avoid any of the rejections set forth in the last Office action, and thus the amendment would not place the case in condition for allowance or in better condition for appeal.

(B) The claims, if amended as proposed, would raise the issue of new matter.

(C) The claims as amended present new issues requiring further consideration or search.

(D) Since the amendment presents additional claims without canceling any finally rejected claims it is not considered as placing the application in better condition for appeal. *Ex parte Wirt*, 1905 C.D. 247, 117 O.G. 599 (Comm'n Pat. 1905).

Examiners should indicate the status of each claim of record or proposed in the amendment, and which proposed claims would be entered on the filing of an appeal if filed in a separate paper.

Applicant should be notified, if certain portions of the amendment would be acceptable as placing some of the claims in better form for appeal or complying with objections or requirements as to form, if a separate paper were filed containing only such amendments. Similarly, if the proposed amendment to some of the claims would render them allowable, applicant should be so informed. This is helpful in assuring the filing of a brief consistent with the claims as amended. A statement that the final rejection stands and that the statutory period runs from the date of the final rejection is also in order.

Advisory Action form PTOL-303 should be used to acknowledge receipt of a reply from applicant after final rejection where such reply is prior to filing of an appeal brief and does not place the application in condition for allowance. This form has been devised to advise applicant of the disposition of the proposed amendments to the claims and of the effect of any argument or affidavit not placing the application in condition for allowance or which could not be made allowable by a telephone call to clear up minor matters.

Any amendment timely filed after a final rejection should be immediately considered to determine whether it places the application in condition for allowance or in better form for appeal. An examiner is expected to turn in a response to an amendment after final rejection within 10 calendar days from the time the amendment is received by the examiner. A reply to an amendment after final rejection

should be mailed within 30 days of the date the amendment is received by the Office. In *all* instances, both before and after final rejection, in which an application is placed in condition for allowance, applicant should be notified promptly of the allowability of the claims by a Notice of Allowability form PTOL-37. If delays in processing the Notice of Allowability are expected, e.g., because an extensive examiner's amendment must be entered, and the end of a statutory period for reply is near, the examiner should notify applicant by way of an interview that the application has been placed in condition for allowance, and an Interview Summary PTOL-413 should be mailed. Prompt notice to applicant is important because it may avoid an unnecessary appeal and act as a safeguard against a holding of abandonment. Every effort should be made to mail the letter before the period for reply expires.

If no appeal has been filed within the period for reply and no amendment has been submitted to make the application allowable or which can be entered in part (see MPEP § 714.20), the application stands abandoned.

It should be noted that under 37 CFR 1.181(f), the filing of a 37 CFR 1.181 petition will not stay the period for reply to an examiner's action which may be running against an application. See MPEP § 1207 for appeal and post-appeal procedure. For after final rejection practice relative to affidavits or declarations filed under 37 CFR 1.131 and 1.132, see MPEP § 715.09 and § 716.

Form paragraphs 7.67-7.80 are to be used when issuing advisory actions after a final rejection.

¶ 7.67 *Advisory After Final, Heading, Before Appeal*

The period for reply [1] to run [2] MONTHS from the mailing date of the final rejection. Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a) accompanied by the appropriate fee. The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. A reply within the meaning of 37 CFR 1.113 must be timely filed to avoid abandonment of this application.

Examiner Note:

1. This paragraph should appear as a heading in all advisory actions prior to appeal. After appeal, use paragraph 7.68.
2. In bracket 1, insert --continues-- if applicant has not submitted a petition for an extension of time along with the appropriate fee under 37 CFR 1.136. If a proper extension has been requested under 37 CFR 1.136, insert --is extended-- in bracket 1.
3. In bracket 2, insert the full statutory period resulting from any extensions of time which have been granted, e.g., --FOUR-- months.
4. DO NOT USE THIS FORM PARAGRAPH FOR REEXAMINATION PROCEEDINGS.
5. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable.

¶ 7.67.01 *Advisory After Final, Heading, 1st Reply Filed Within 2 Months*

The shortened statutory period for reply expires THREE MONTHS from the mailing date of the final rejection or as of the mailing date of this

advisory action, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Any extension fee required pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for reply expires as set forth above.

Examiner Note:

1. This paragraph should be used in all advisory actions if:
 - a. it was the FIRST reply to the final rejection, and
 - b. it was filed within two months of the date of the final rejection.
2. If a notice of appeal has been filed, also use paragraph 7.68.
3. DO NOT USE THIS FORM PARAGRAPH FOR REEXAMINATION PROCEEDINGS.
4. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable.

¶ 7.67.02 Advisory After Final, Heading, No Variable SSP Set in Final

Since the first reply to the final Office action was filed within TWO MONTHS of the mailing date of that action and the advisory action was not mailed within THREE MONTHS of that date, the THREE-MONTH shortened statutory period for reply set in the final Office action is hereby vacated and reset to expire as of the mailing date of this advisory action. See Notice entitled "Procedure for Handling Amendments Under 37 CFR 1.116," published in the Official Gazette at 1027 O.G. 71, February 8, 1983. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final Office action.

Any extension fee required pursuant to 37 CFR 1.17 will be calculated from the mailing date of the advisory action.

Examiner Note:

1. This paragraph should be used in all advisory actions where:
 - a. the reply is a first reply to the final action;
 - b. the reply was filed within two months of the mailing date of the final; and
 - c. the final action failed to inform applicant of a variable SSP beyond the normal three month period, as is set forth in form paragraphs 7.39 to 7.41.
2. If the final action set a variable SSP, do not use this paragraph, use paragraph 7.67.01 instead.
3. If a notice of appeal has been filed, also use paragraph 7.68.
4. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable.

¶ 7.68 Advisory After Final, Heading, After Appeal

An appeal under 37 CFR 1.191 was filed in this application on [1]. Appellant's brief is due on [2] in accordance with 37 CFR 1.192(a).

Examiner Note:

1. This paragraph must precede paragraph 7.70 if the amendment is entered.
2. This paragraph must precede paragraph 7.71 if the amendment is not entered.

¶ 7.69 Advisory After Final, Before Appeal, Amendment To Be Entered

The amendment filed [1] under 37 CFR 1.116 in reply to the final rejection will be entered upon the filing of an appeal, but is not deemed to place the application in condition for allowance. Upon the filing of an appeal and entry of the amendment, the status of the claims would be as follows:

Allowed claim(s): [2]
 Rejected claim(s): [3]
 Claim(s) objected to: [4]

Examiner Note:

1. This paragraph must be preceded by paragraph 7.67, 7.67.01 or 7.67.02.
2. In brackets 2-4 indicate the status of all claims.
3. Whenever an amendment is entered for appeal purposes, you must follow the last paragraph above with form paragraph 7.69.01 or other language to indicate how the new or amended claim(s) would be rejected (whether the rejections are exactly the same as in the final Office action or there is a shift to one or more different individual grounds of rejection in the final Office action). This may be done by using form paragraph 7.69.01 for each group of claims subject to the same rejection.

¶ 7.69.01 Advisory Action, Proposed Rejection of Claims, Before Appeal

See 37 CFR 1.193(a)(2) which provides for the inclusion of the proposed rejection(s) detailed below in the Examiner's Answer if applicant elects to file an appeal to the Board of Patent Appeals and Interferences in this proceeding. To be complete, such rejection(s) must be addressed in any brief on appeal.

Upon appeal and entry of the amendment:

Claim(s) [1] would be rejected for the reasons set forth in [2] of the final Office action mailed [3].

Examiner Note:

1. In bracket 1, identify all the new or amended claim(s) that would be grouped together in a single rejection.
2. In bracket 2, identify the rejection by referring to either the paragraph number or the statement of the rejection (i.e., the rejection under 35 U.S.C. § 103 based upon A in view of B) in the final Office action under which the claims would be rejected on appeal.
3. Repeat this form paragraph for each group of claims subject to the same rejection(s).
4. A statement of reasons for allowance, or other appropriate information may be added if necessitated by entry of the amendment.

¶ 7.70 Advisory After Final, After Appeal, Amendment Entered

The amendment filed [1] under 37 CFR 1.116 in reply to the final rejection has been entered, but is not deemed to place the application in condition for allowance. For purposes of appeal, the status of the claims is as follows:

Allowed claim(s): [2]
 Rejected claim(s): [3]
 Claim(s) objected to: [4]

Examiner Note:

1. This paragraph must be preceded by paragraph 7.68.
2. In brackets 2-4 indicate the status of all pending claims.
3. Whenever an amendment is entered for appeal purposes, you must follow the last paragraph above with form paragraph 7.69.01 or other language to indicate how the new or amended claim(s) would be rejected (whether the rejections are exactly the same as in the final Office action or there is a shift to one or more different individual grounds of rejection in the final Office action). This may be done by using form paragraph 7.70.01 for each group of claims subject to the same rejection.
4. A statement of reasons for allowance, or other appropriate information may be added if necessitated by entry of the amendment.

¶ 7.70.01 Advisory Action, Proposed Rejection of Claims, After Appeal

See 37 CFR 1.193(a)(2) which provides for the inclusion of the proposed rejection(s) detailed below in the Examiner's Answer if applicant elects to file an appeal to the Board of Patent Appeals and Interferences in this proceeding. To be complete, such rejection(s) must be addressed in any brief on appeal.

Claim(s) [1] would be rejected for the reasons set forth in [2] of the final Office action mailed [3].

Examiner Note:

1. In bracket 1, identify all the new or amended claim(s) that would be grouped together in a single rejection.
2. In bracket 2, identify the rejection by referring to either the paragraph number or the statement of the rejection (i.e., the rejection under 35 U.S.C. § 103 based upon A in view of B) in the final Office action under which the claims would be rejected on appeal.
3. Repeat this form paragraph for each group of claims subject to the same rejection(s).
4. A statement of reasons for allowance, or other appropriate information may be added if necessitated by entry of the amendment.

¶ 7.71 Advisory After Final, Amendment Not Entered

The amendment filed [1] under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because:

Examiner Note:

1. This paragraph must be preceded by paragraph 7.67, 7.67.01 or 7.67.02 if an appeal has not been taken, or by paragraph 7.68 if an appeal has been taken.
2. If it is not known whether a notice of appeal has been filed and the full six month period has expired, do not use paragraphs 7.67, 7.67.01, 7.67.02 or 7.68; use instead the following: "If an appeal under 37 CFR 1.191 has not been properly filed, this application is abandoned."
3. One or more of the appropriate paragraphs 7.72 to 7.76 must directly follow this paragraph.

¶ 7.72 Advisory After Final, Lacks Showing, Why Necessary and Not Earlier Presented

There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.

Examiner Note:

1. Paragraph 7.71 must precede this paragraph.
2. Do not use this paragraph as the sole reason for refusing entry of the amendment unless the situation is aggravated, in which case a full explanation is necessary.
3. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable and only if not used in previous action.

¶ 7.73 Advisory After Final, Raises New Issues

The proposed amendment raises new issues that would require further consideration and/or search.

Examiner Note:

1. This paragraph must be preceded by paragraph 7.71.
2. The new issues including questions of new matter must be clearly identified following this form paragraph. (Examples are sufficient if the new issues are extensive.)
3. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable and only if not used in previous action.

¶ 7.75 Advisory After Final, Form for Appeal Not Improved

The proposed amendment is not deemed to place the application in better form for appeal by materially simplifying the issues for appeal.

Examiner Note:

1. This paragraph must be preceded by paragraph 7.71.
2. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable and only if not used in a previous action.

¶ 7.76 Advisory After Final, Additional Claims Presented

The proposed amendment presents additional claims without canceling a corresponding number of finally rejected claims.

Examiner Note:

1. This paragraph must be preceded by paragraph 7.71.
2. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable and only if not used in a previous action.

¶ 7.78 Advisory After Final, Proposed New Claims Would Be Allowable

Claim [1] as proposed would be allowable if submitted in a separately filed amendment canceling all non-allowed claims.

Examiner Note:

1. This paragraph must be preceded by paragraph 7.71.
2. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable and only if not used in a previous action.

¶ 7.79 Advisory After Final, Affidavit, Exhibit, or Request for Reconsideration Considered

The [1] has been entered and considered but does not overcome the rejection because [2].

Examiner Note:

1. This paragraph must be preceded by either paragraph 7.67, 7.67.01, 7.67.02 or 7.68.
2. In bracket 1, insert --affidavit--, --declaration--, --exhibit--, or --request for reconsideration--.
3. An explanation should be provided in bracket 2.
4. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable and only if not used in a previous action.

¶ 7.80 Advisory After Final, Affidavit or Exhibit Not Considered

The [1] will not be considered because good and sufficient reasons why it was not earlier presented have not been shown. [2]

Examiner Note:

1. This paragraph must be preceded by either paragraph 7.67, 7.67.01, 7.67.02 or 7.68.
2. In bracket 1, insert --affidavit--, --declaration--, --exhibit--, or --request for reconsideration--.
3. An explanation should follow in bracket 2.
4. Follow with form paragraph 7.41.01 if transitional provisions of 37 CFR 1.129(a) are applicable and only if not used in a previous action.

HAND DELIVERY OF PAPERS

Any paper which relates to a pending application may be personally delivered to an examining group. However, the examining group will accept the paper only if: (1) the paper is accompanied by some form of receipt which can be handed back to the person delivering the paper; and (2) the examining group being asked to receive the paper is responsible for acting on the paper.

The receipt may take the form of a card identifying the paper. The identifying data on the card should be so complete as to leave no uncertainty as to the paper filed. For example, the card should contain the applicant's name(s), application number, filing date, and a description of the paper being filed. If more than one paper is being filed for

the same application, the card should contain a description of each paper or item.

Under this procedure, the paper and receipt will be date stamped with the group date stamp. The receipt will be handed back to the person hand delivering the paper. The paper will be correlated with the application and made an official paper in the file, thereby avoiding the necessity of processing and forwarding the paper to the examining group via the Mail Center.

The examining group will accept and date stamp a paper even though the paper is accompanied by a check or the paper contains an authorization to charge a Deposit Account. However, in such an instance, the paper will be hand carried by group personnel to the Office of Finance for processing and then made an official paper in the file.

All such papers, together with the cash, checks, or money orders, shall be hand-carried to the Customer Service window, Crystal Plaza Building 2, Room 1B01.

The papers shall be processed by the accounting clerk, Office of Finance, for pickup at the Customer Service window by 3:00 p.m. the following work day. Upon return to the group, the papers will be entered in the application file wrappers.

EXPEDITED PROCEDURE FOR PROCESSING AMENDMENTS AND OTHER REPLIES AFTER FINAL REJECTION (37 CFR 1.116)

In an effort to improve the timeliness of the processing of amendments and other replies under 37 CFR 1.116, and thereby provide better service to the public, an expedited processing procedure has been established which the public may utilize in filing amendments and other replies after final rejection under 37 CFR 1.116. In order for an applicant to take advantage of the expedited procedure the amendment or other reply under 37 CFR 1.116 will have to be marked as a "Reply under 37 CFR 1.116 — Expedited Procedure - Examining Group (Insert Examining Group Number)" on the upper right portion of the amendment or other reply and the envelope must be marked "Box AF" in the lower left hand corner. The markings preferably should be written in a bright color with a felt point marker. If the reply is mailed to the Office, the envelope should contain only replies under 37 CFR 1.116 and should be mailed to "Box AF, Assistant Commissioner for Patents, Washington, D.C. 20231." Instead of mailing the envelope to "Box AF" as noted above, the reply may be hand-carried to the particular examining group or other area of the Office in which the application is pending and marked on the outside envelope "Reply Under 37 CFR 1.116 - Expedited Procedure-Examining Group (Insert Examining Group Number)."

Upon receipt by the Patent and Trademark Office from the U.S. Postal Service of an envelope appropriately

marked "Box AF," the envelope will be specially processed by the Mail Center and forwarded promptly to the examining group, via the Office of Finance if any fees have to be charged or otherwise processed. Upon receipt of the reply in the examining group it will be promptly processed by a designated technical support staff member and forwarded to the examiner, via the Supervisory Patent Examiner (SPE), for action. The SPE is responsible for ensuring that prompt action on the reply is taken by the examiner. If the examiner to which the application is assigned is not available and will not be available for an extended period, the SPE will ensure that action on the application is promptly taken to assure meeting the PTO goal described below. Once the examiner has completed his or her consideration of the reply, the examiner's action will be promptly typed and mailed by technical support staff personnel designated to expedite the processing of replies filed under this procedure. The examining group supervisory personnel, e.g., the Supervisory Patent Examiner, Supervisory Applications Examiner, and Group Director are responsible for ensuring that actions on replies filed under this procedure are promptly processed and mailed. The Patent and Trademark Office goal is to mail the examiner's action on the reply within 1 month from the date on which the amendment or reply is received by the Patent and Trademark Office.

Applicants are encouraged to utilize this expedited procedure in order to facilitate Patent and Trademark Office processing of replies under 37 CFR 1.116. If applicants do not utilize the procedure by appropriately marking the envelope and enclosed papers, the benefits expected to be achieved therefrom will not be attained. The procedure cannot be expected to result in achievement of the goal in applications in which the delay results from actions by the applicant, e.g., delayed interviews, applicant's desire to file a further reply, or a petition by applicant which requires a decision and delays action on the reply. In any application in which a reply under this procedure has been filed and no action by the examiner has been received within the time referred to herein, plus normal mailing time, a telephone call to the SPE of the relevant group art unit would be appropriate in order to permit the SPE to determine the cause for any delay. If the SPE is unavailable or if no satisfactory reply is received, the Group Director of the examining group should be contacted.

714.14 Amendments After Allowance of All Claims

Under the decision in *Ex parte Quayle*, 25 USPQ 74, 1935 C.D. 11; 453 O.G. 213 (Comm'r Pat. 1935), after all claims in a case have been allowed the prosecution of the case on the merits is closed even though there may be

Chapter 1200 Appeal

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1201 Introduction

The Patent and Trademark Office in administering the Patent Laws makes many decisions of a discretionary nature which the applicant may feel deny him or her the patent protection to which he or she is entitled. The differences of opinion on such matters can be justly resolved only by prescribing and following judicial procedures. Where the differences of opinion concern the denial of patent claims because of prior art or material deficiencies in

the disclosure set forth in the application, the questions thereby raised are said to relate to the merits, and appeal procedure within the Patent and Trademark Office and to the courts has long been provided by statute.

The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Commissioner of Patents and Trademarks should be carefully observed. The Board will not ordinarily hear a question which it believes should be decided by the Commissioner, and the Commissioner will not ordinarily entertain a petition where the question presented is an appealable matter. However, since 37 CFR 1.181(f) states that any petition not filed within 2 months from the action complained of may be dismissed as untimely and since 37 CFR 1.144 states that petitions from restriction requirements must be filed no later than appeal, petitionable matters will rarely be present in a case by the time it is before the Board for a decision. *In re Watkinson*, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990).

1203 Composition of Board

35 U.S.C. 7 provides for a Board of Patent Appeals and Interferences as follows:

35 U.S.C. 7. Board of Patent Appeals and Interferences.

(a) The examiners-in-chief shall be persons of competent legal knowledge and scientific ability, who shall be appointed to the competitive service. The Commissioner, the Deputy Commissioner, the Assistant Commissioners, and the examiners-in-chief shall constitute the Board of Patent Appeals and Interferences.

(b) The Board of Patent Appeals and Interferences shall, on written appeal of an applicant, review adverse decisions of examiners upon applications for patents and shall determine priority and patentability of invention in interference declared under section 135(a) of this title. Each appeal and interference shall be heard by at least three members of the Board of Patent Appeals and Interferences, who shall be designated by the Commissioner. Only the Board of Patent Appeals and Interferences has the authority to grant rehearings.

(c) Whenever the Commissioner considers it necessary, in order to keep current the work of the Board of Patent Appeals and Interferences, the Commissioner may designate any patent examiner of the primary examiner grade or higher, having the requisite ability, to serve as examiner-in-chief for periods not exceeding six months each. An examiner so designated shall be qualified to act as a member of the Board of Patent Appeals and Interferences. Not more than one of the members of the Board of Patent Appeals and Interferences hearing an appeal or determining an interference may be an examiner so designated. The Secretary of Commerce is authorized to fix the pay of each designated examiner-in-chief in the Patent and Trademark Office at not to exceed the maximum rate of basic pay payable for grade GS-16 of the General Schedule under section 5332 of title 5. The rate of basic pay of each individual designated examiner-in-chief shall be adjusted, at the close of the period for which that individual was designated to act examiner-in-chief, to the rate of basic pay that individual would have been receiving at the close of such period if such designation had not been made.

The Commissioner's Notice of October 15, 1993 (1156 O.G. 32, Nov. 9, 1993) authorizes the Chairman, Vice

Chairman and Examiners-in-Chief of the Board to use the respective titles Chief Administrative Patent Judge, Vice Chief Administrative Patent Judge, and Administrative Patent Judge for signing all correspondence and decisions, and for other business-related activities.

If subsequent to the hearing, but prior to the decision, an administrative patent judge (referred to as an "examiner-in-chief" in 35 U.S.C. 7) who heard the appeal becomes unable to participate in the decision or any subsequent action for some reason, the Chief Administrative Patent Judge of the Board, at his or her discretion, may without a rehearing substitute a different Board member for the one who is unavailable, or may offer the appellant the opportunity for a rehearing. See *In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985).

Should a member die or otherwise become unavailable (for example, retirement) to reconsider a decision, normally another member will be designated by the Chief Administrative Patent Judge as a substitute for the absent member.

1204 Administrative Handling

Ex parte appeals to the Board, and all papers relating thereto, are forwarded to the examining group for docketing. All appeal papers, such as the notice of appeal, appeal brief, and request for extension of time to file the brief, are processed by the appropriate examining group.

To ensure that all records are current, memorandum form PTO-262 is attached to the file wrapper when it is remanded by the Board. It is important that this memorandum be promptly completed and forwarded by the group if the application is allowed, the prosecution is reopened, a continuation application is filed, or if the appeal is discontinued for any other reason.

If the brief is not filed within the time designated by 37 CFR 1.192, the applicant will be notified that the appeal stands dismissed.

"SPECIAL CASE"

Subject alone to diligent prosecution by the applicant, an application for patent that once has been made special and advanced out of turn by the Office for examination will continue to be special throughout its entire course of prosecution in the Patent and Trademark Office, including appeal, if any, to the Board. See MPEP § 708.02.

A petition to make an application special after the appeal has been forwarded to the Board may be addressed to the Board. However, no such petition will be granted unless the brief has been filed and applicant has made the same type of showing required by the Commissioner under 37 CFR 1.102. Therefore, diligent prosecution is essential to a favorable decision on a petition to make special.

1205 Notice of Appeal [R-1]

35 U.S.C. 134. *Appeal to the Board of Patent Appeals and Interferences.*

**>

(a) PATENT APPLICANT.— An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the administrative patent judge to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

(b) PATENT OWNER.— A patent owner in any reexamination proceeding may appeal from the final rejection of any claim by the administrative patent judge to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

(c) THIRD-PARTY.— A third-party requester in an inter partes proceeding may appeal to the Board of Patent Appeals and Interferences from the final decision of the administrative patent judge favorable to the patentability of any original or proposed amended or new claim of a patent, having once paid the fee for such appeal. The third-party requester may not appeal the decision of the Board of Patent Appeals and Interferences.<

35 U.S.C. 41. *Patent fees*

(a) The Commissioner shall charge the following fees:

**>

(6)(A) On filing an appeal from the examiner to the Board of Patent Appeals and Interferences, \$300.

(B) In addition, on filing a brief in support of the appeal, \$300, and on requesting an oral hearing in the appeal before the Board of Patent Appeals and Interferences, \$260.<

**

37 CFR 1.191. *Appeal to Board of Patent Appeals and Interferences.*

(a) Every applicant for a patent or for reissue of a patent, and every owner of a patent under reexamination, any of whose claims has been twice or finally (§ 1.113) rejected, may appeal from the decision of the examiner to the Board of Patent Appeals and Interferences by filing a notice of appeal and the fee set forth in § 1.17(b) within the time period provided under §§ 1.134 and 1.136 for reply.

(b) The signature requirement of § 1.33 does not apply to a notice of appeal filed under this section.

(c) An appeal when taken must be taken from the rejection of all claims under rejection which applicant or patent owner proposes to contest. Questions relating to matters not affecting the merits of the invention may be required to be settled before an appeal can be considered.

(d) The time periods set forth in §§ 1.191 and 1.192 are subject to the provisions of § 1.136 for patent applications and § 1.550(c) for reexamination proceedings. The time periods set forth in §§ 1.193, 1.194, 1.196, and 1.197 are subject to the provisions of § 1.136(b) for patent applications or § 1.550(c) for reexamination proceedings. See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.

(e) Jurisdiction over the application or patent under reexamination passes to the Board of Patent Appeals and Interferences upon transmittal of the file, including all briefs and examiner's answers, to the Board. Prior to the entry of a decision on the appeal, the Commissioner may sua sponte order the application remanded to the examiner.

Under 37 CFR 1.191(a), an applicant or patent owner in a reexamination proceeding dissatisfied with the primary examiner's decision in the second or final rejection of his or her claims may appeal to the Board for review of the examiner's rejection by filing a notice of appeal and the required fee set forth in 37 CFR 1.17(b) within the time period provided under 37 CFR 1.134 and 1.136. A notice of appeal may be filed after any of the claims has been twice rejected, regardless of whether the claim(s) has/have been finally rejected. The limitation of "twice or finally...rejected" does not have to be related to a particular application. For example, if any claim was rejected in a parent application, and the claim is again rejected in a continuing application, then applicant will be entitled to file an appeal in the continuing application, even if the claim was rejected only once in the continuing application.

Although the rules no longer require that the notice of appeal identify the rejected claim(s) appealed, or be signed, applicants should * continue to file notices of appeal which identify the appealed claims and are signed. The requirement was eliminated from 37 CFR 1.191 as being redundant of the requirements of 37 CFR 1.192 and to avoid the delay and expense to both applicant and the PTO which is involved in treating a defective notice of appeal. It should be noted that the elimination of the requirement to sign a notice of appeal does not affect the requirements for other papers (such as an amendment under 37 CFR 1.116) submitted with the notice, or for other actions contained within

the notice, e.g., an authorization to charge fees to a deposit account. Thus, failure to sign the notice of appeal may have unintended adverse consequences; for example, if an unsigned notice of appeal contains an (unsigned) authorization to charge the appeal fee to a deposit account, the notice of appeal will be unacceptable because the appeal fee is lacking.

The notice of appeal must be filed within the period for reply set in the last Office action, which is normally 3 months for applications. See MPEP § 714.13. Failure to remove all grounds of rejection and otherwise place an application in condition for allowance or to file an appeal after final rejection will result in the application becoming abandoned, even if one or more claims have been allowed, except where claims suggested for interference have been copied. The notice of appeal and appropriate fee may be filed up to 6 months from the date of the final rejection, so long as an appropriate petition and fee for an extension of time is filed either prior to or with the notice of appeal. Failure to file an appeal in a reexamination proceeding will result in issuance of the certificate under 37 CFR 1.570.

37 CFR 1.191 provides for appeal to the Board by the patent owner from any decision in a reexamination proceeding adverse to patentability, in accordance with 35 U.S.C. 306. See also MPEP § 2273.

The use of a separate letter containing the notice of appeal is strongly recommended. Form PTO/SB/31 may be used for filing a notice of appeal.

PTO/SB/31 (12-87)
Approved for use through 9/30/00. OMB 0651-0031
Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

NOTICE OF APPEAL FROM THE EXAMINER TO THE BOARD OF PATENT APPEALS AND INTERFERENCES		Docket Number (Optional)
In re Application of		
Application Number	Filed	
For		
Group Art Unit	Examiner	
<p>Applicant hereby appeals to the Board of Patent Appeals and Interferences from the decision of the examiner dated, _____, rejecting the following claims: _____</p> <p>_____</p> <p>The fee for this Notice of Appeal is (37 CFR 1.17(b)) \$_____</p> <p><input type="checkbox"/> Applicant is a small entity under 37 CFR 1.9 and 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is: \$_____</p> <p>A statement of small entity status under 37 CFR 1.27:</p> <p><input type="checkbox"/> is enclosed.</p> <p><input type="checkbox"/> has already been filed in this application.</p> <p><input type="checkbox"/> A check in the amount of the fee is enclosed.</p> <p><input type="checkbox"/> The Commissioner has already been authorized to charge fees in this application to a Deposit Account. I have enclosed a duplicate copy of this sheet.</p> <p><input type="checkbox"/> The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. _____. I have enclosed a duplicate copy of this sheet.</p> <p><input type="checkbox"/> A petition for an extension of time under 37 CFR 1.136(a) (PTO/SB/22) is enclosed.</p> <p>I am the</p> <p><input type="checkbox"/> applicant.</p> <p><input type="checkbox"/> assignee of record of the entire interest.</p> <p><input type="checkbox"/> attorney or agent of record.</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34(a).</p> <p style="padding-left: 40px;">Registration number if acting under 37 CFR 1.34(a) _____</p> <div style="text-align: right; margin-top: 20px;"> <p>_____ Signature</p> <p>_____ Typed or printed name</p> <p>_____ Date</p> </div>		

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.**

MATTERS HANDLED CONCURRENTLY WITH APPEAL

The Patent and Trademark Office does not acknowledge receipt of a Notice of Appeal by separate letter. However, if a self-addressed postcard is included with the Notice of Appeal, it will be date stamped and mailed.

Form paragraphs 12.01-12.04 may be used to indicate defects in a Notice of Appeal.

¶ 12.01 Notice of Appeal Unacceptable - Fee Unpaid

The notice of appeal filed on [1] is not acceptable because the appeal fee required under 37 CFR 1.17(b) was not filed, or was not timely filed.

Applicant may obtain an extension of time under 37 CFR 1.136(a) to file the appropriate appeal fee. The date on which the notice of appeal, the appeal fee, the petition under 37 CFR 1.136(a), and the petition fee are filed will be the date of the reply and also the date for determining the period of extension and the corresponding amount of the fee. In no case may an applicant reply later than the maximum SIX MONTH statutory period or obtain an extension pursuant to 37 CFR 1.136(a) for more than FIVE MONTHS beyond the date of reply set in an Office action.

¶ 12.02 Notice of Appeal Unacceptable - No 2nd Rejection

The notice of appeal filed on [1] is not acceptable because there has been no second or final rejection in this application, as required under 37 CFR 1.191(a).

¶ 12.03 Notice of Appeal Unacceptable - Not Timely Filed

The notice of appeal filed on [1] is not acceptable because it was filed after the expiration of the period set in the prior Office action. This application will become abandoned unless applicant obtains an extension under 37 CFR 1.136(a). The date on which the notice of appeal, the appeal fee, the petition under 37 CFR 1.136(a), and the petition fee under 37 CFR 1.17(a) are filed will be the date of the reply and also the date for determining the period of extension and the corresponding amount of the fee. In no case may an applicant reply later than the maximum SIX MONTH statutory period or obtain an extension pursuant to 37 CFR 1.136(a) for more than FIVE MONTHS beyond the date of reply set in an Office action.

¶ 12.04 Notice of Appeal Unacceptable - Claims Allowed

The notice of appeal filed on [1] is not acceptable because a notice of allowability was mailed by the Office on [2].

1206 Appeal Brief [R-1]

37 CFR 1.192. Appellant's brief.

(a) Appellant must, within two months from the date of the notice of appeal under § 1.191 or within the time allowed for reply to the action from which the appeal was taken, if such time is later, file a brief in triplicate. The brief must be accompanied by the fee set forth in § 1.17(c) and must set forth the authorities and arguments on which appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.

(b) On failure to file the brief, accompanied by the requisite fee, within the time allowed, the appeal shall stand dismissed.

(c) The brief shall contain the following items under appropriate headings and in the order indicated below unless the brief is filed by an applicant who is not represented by a registered practitioner:

(1) *Real party in interest.* A statement identifying the real party in interest, if the party named in the caption of the brief is not the real party in interest.

(2) *Related appeals and interferences.* A statement identifying by number and filing date all other appeals or interferences known to appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) *Status of claims.* A statement of the status of all the claims, pending or canceled, and identifying the claims appealed.

(4) *Status of amendments.* A statement of the status of any amendment filed subsequent to final rejection.

(5) *Summary of invention.* A concise explanation of the invention defined in the claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters.

(6) *Issues.* A concise statement of the issues presented for review.

(7) *Grouping of claims.* For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

(8) *Argument.* The contentions of appellant with respect to each of the issues presented for review in paragraph (c)(6) of this section, and the basis therefor, with citations of the authorities, statutes, and parts of the record relied on. Each issue should be treated under a separate heading.

(i) For each rejection under 35 U.S.C. 112, first paragraph, the argument shall specify the errors in the rejection and how the first paragraph of 35 U.S.C. 112 is complied with, including, as appropriate, how the specification and drawings, if any,

(A) describe the subject matter defined by each of the rejected claims,

(B) enable any person skilled in the art to make and use the subject matter defined by each of the rejected claims, and

(C) set forth the best mode contemplated by the inventor of carrying out his or her invention.

(ii) For each rejection under 35 U.S.C. 112, second paragraph, the argument shall specify the errors in the rejection and how the claims particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(iii) For each rejection under 35 U.S.C. 102, the argument shall specify the errors in the rejection and why the rejected claims are patentable under 35 U.S.C. 102, including any specific limitations in the rejected claims which are not described in the prior art relied upon in the rejection.

(iv) For each rejection under 35 U.S.C. 103, the argument shall specify the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection, and shall explain how such limitations render the claimed subject matter unobvious over the prior art. If the rejection is based upon a combination of references, the argument shall explain why the references, taken as a whole, do not suggest the claimed subject matter, and shall include, as may be appropriate, an explanation of why features disclosed in one reference may not properly be combined with features disclosed in another reference. A general argument that all the limitations are not described in a single reference does not satisfy the requirements of this paragraph.

(v) For any rejection other than those referred to in paragraphs (c)(8)(i) to (iv) of this section, the argument shall specify the errors in the rejection and the specific limitations in the rejected claims, if appropriate, or other reasons, which cause the rejection to be in error.

(9) *Appendix.* An appendix containing a copy of the claims involved in the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and provided with a period of one month within which to file an amended brief. If appellant does not file an amended brief during the one-month period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

Where the brief is not filed, but within the period allowed for filing the brief an amendment is presented which places the application in condition for allowance, the amendment may be entered since the application retains its pending status during said period. Amendments should not be included in the appeal brief. Amendments should be filed as separate papers. See MPEP § 1207, § 1215.01, and § 1215.02.

TIME FOR FILING APPEAL BRIEF

37 CFR 1.192(a) provides 2 months from the date of the Notice of Appeal for the appellant to file an appeal brief. In a reexamination proceeding, the time period can be extended only under the provisions of 37 CFR 1.550(c). See also MPEP § 2274.

The usual period of time in which appellant must file his or her brief is 2 months from the date of appeal. The Office date of receipt of the Notice of Appeal (and not the date indicated on any Certificate of Mailing under 37 CFR 1.8) is the date from which this 2 month time period is measured. See MPEP § 512. However, 37 CFR 1.192(a) alternatively permits the brief to be filed "within the time allowed for reply to the action from which the appeal was taken, if such time is later." These time periods may be extended under 37 CFR 1.136(a), and if 37 CFR 1.136(a) is not available, under 37 CFR 1.136(b) for extraordinary circumstances.

In the event that the appellant finds that he or she is unable to file a brief within the time period allotted by the rules, he or she may file a petition, with fee, to the examining group, requesting additional time under 37 CFR 1.136(a). Additional time in excess of 5 months will not be granted unless extraordinary circumstances are involved under 37 CFR 1.136(b). The time extended is added to the calendar day of the original period, as opposed to being added to the day it would have been due when said last day is a Saturday, Sunday, or Federal holiday.

If after an appeal has been filed, but prior to the date for submitting a brief, an interference is declared, appellant's brief need not be filed while the interference is pending, unless the administrative patent judge has consented to prosecution of the application concurrently with the interference. See MPEP § 2315. Absent such concurrent prosecution, the examiner may, after the interference has

terminated and the files have been returned to him or her, (A) set a 2-month period for filing the brief, or (B) withdraw the final rejection of the appealed claims in order to enter an additional rejection on a ground arising out of the interference. See, for example, MPEP § 2363.03. Also, if the appellant was the losing party in the interference, claims which were designated as corresponding to the lost count or counts will stand finally disposed of under 37 CFR 1.663.

When an application is revived after abandonment for failure on the part of the appellant to take appropriate action after final rejection, and the petition to revive was accompanied by a Notice of Appeal, appellant has 2 months, from the mailing date of the Commissioner's affirmative decision on the petition, in which to file the appeal brief. The time period for filing the appeal brief may be extended under 37 CFR 1.136.

With the exception of a declaration of an interference or suggestion of claims for an interference and timely copying of claims for an interference, the appeal ordinarily will be dismissed if the brief is not filed within the period provided by 37 CFR 1.192(a) or within such additional time as may be properly extended.

A brief must be filed to preserve appellant's right to the appealed claims, notwithstanding circumstances such as:

(A) the possibility or imminence of an interference involving the subject application, but not resulting in withdrawal of the final rejection prior to the brief's due date;

(B) the filing of a petition for supervisory action under 37 CFR 1.181;

(C) the filing of an amendment, even if it is one which the examiner previously has indicated may place one or more claims in condition for allowance, unless the examiner, in acting on the amendment, disposes of all issues on appeal;

(D) the receipt of a letter from the examiner stating that prosecution is suspended, without the examiner withdrawing the final rejection from which appeal has been taken or suggesting claims for an interference, and without an administrative patent judge declaring an interference with the subject application.

Although failure to file the brief within the permissible time will result in dismissal of the appeal, if any claims stand allowed, the application does not become abandoned by the dismissal, but is returned to the examiner for action on the allowed claims. See MPEP § 1215.04. If there are no allowed claims, the application is abandoned as of the date the brief was due. Claims which have been objected to as dependent from a rejected claim do not stand allowed. In a reexamination proceeding failure to file the brief will result in the issuance of the certificate under 37 CFR 1.570.

If the time for filing a brief has passed and the application has consequently become abandoned, the applicant may petition to revive the application, as in other cases of abandonment, and to reinstate the appeal; if the appeal is dismissed, but the application is not abandoned, the petition would be to reinstate the claims and the appeal, but a showing equivalent to that in a petition to revive under 37 CFR 1.137 is required. In either event, a proper brief must be filed before the petition will be considered on its merits.

Where the dismissal of the appeal is believed to be in error, filing a petition, pointing out the error, may be sufficient.

A fee under 37 CFR 1.17(c) is required when the brief is filed. 37 CFR 1.192(a) requires the submission of three copies of the appeal brief.

APPEAL BRIEF CONTENT

The brief, as well as every other paper relating to an appeal, should indicate the number of the examining group to which the application or patent under reexamination is assigned and the application or reexamination control number. When the brief is received, it is forwarded to the group where it is entered in the file, and referred to the examiner.

An appellant's brief must be responsive to every ground of rejection stated by the examiner.

Where an appeal brief fails to address any ground of rejection, appellant shall be notified by the examiner that he or she must correct the defect by filing a brief (in triplicate) in compliance with 37 CFR 1.192(c). See 37 CFR 1.192(d). Form paragraphs 12.76-12.76.06 and 12.78, or form PTOL-462, "Notification of Non-Compliance with 37 CFR 1.192(c)," may be used to notify the appellant of the deficiency. Oral argument at a hearing will not remedy such deficiency of a brief. The fact that appellant may consider a ground to be clearly improper does not justify a failure to point out to the Board the reasons for that belief.

The mere filing of paper entitled as a brief will not necessarily be considered to be in compliance with 37 CFR 1.192(c). The rule requires that the brief must set forth the authorities and arguments relied upon. Since it is essential that the Board should be provided with a brief fully stating the position of the appellant with respect to each issue involved in the appeal so that no search of the record is required in order to determine that position, 37 CFR 1.192(c) requires that the brief contain specific items, as discussed below.

An exception to the requirement that all the items specified in 37 CFR 1.192(c) be included in the brief is made if the application or reexamination proceeding is being prosecuted by the appellant *pro se*, i.e., there is no attorney or agent of record, and the brief was neither prepared nor signed by a registered attorney or agent. The brief of a *pro*

se appellant which does not contain all of the items, (1) to (9), specified in 37 CFR 1.192(c) will be accepted as long as it substantially complies with the requirements of items (1), (2), and (8). If the brief of a *pro se* appellant is accepted, it will be presumed that all the claims of a rejected group of claims stand or fall together unless an argument is included in the brief that presents reasons as to why the appellant considers one or more of the claims in the rejected group to be separately patentable from the other claims in the group.

A distinction must be made between the lack of any argument and the presentation of arguments which carry no conviction. In the former case, notification of a defective appeal brief is in order, while in the latter case, the application or reexamination is forwarded to the Board for a decision on the merits. As noted above, the examiner may use form paragraphs 12.76-12.76.06 and 12.78, or form PTOL-462, "Notification of Non-Compliance with 37 CFR 1.192(c)," to notify appellant that the appeal brief is defective.

If in his or her brief, appellant relies on some reference, he or she is expected to provide the Board with three copies of it.

The specific items required by 37 CFR 1.192(c) are:

(1) *Real party in interest.* A statement identifying the real party in interest, if the party named in the caption of the brief is not the real party in interest. If appellant does not name a real party in interest, the examiner will assume that the party named in the caption of the brief is the real party in interest, i.e., the owner at the time the brief is being filed.

The identification of the real party in interest will allow members of the Board to comply with ethics regulations associated with working in matters in which the member has a financial interest to avoid any potential conflict of interest. While the examiner will assume that the real party in interest is the individual or individuals identified in the caption when the real party in interest is not explicitly set out in the brief, nevertheless, the Board may require the appellant to explicitly name the real party in interest. See MPEP § 1210.01.

(2) *Related appeals and interferences.* A statement identifying by application number and filing date all other appeals or interferences known to appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. The appeal or interference number should also be listed. The statement is not limited to copending applications. If appellant does not identify any other appeals or interferences, the examiner will presume that there are none. While the examiner will assume that there are no related cases when no related case is

explicitly set out in the brief, nevertheless, the Board may require the appellant to explicitly identify any related case. See MPEP § 1210.01.

(3) *Status of Claims.* A statement of the status of all the claims in the application, or patent under reexamination, i.e., for each claim in the case, appellant must state whether it is cancelled, allowed, rejected, etc. Each claim on appeal must be identified.

(4) *Status of Amendments.* A statement of the status of any amendment filed subsequent to final rejection, i.e., whether or not the amendment has been acted upon by the examiner, and if so, whether it was entered, denied entry, or entered in part. This statement should be of the status of the amendment as understood by the appellant.

Items (3) and (4) are included in 37 CFR 1.192(c) to avoid confusion as to which claims are on appeal, and the precise wording of those claims, particularly where the appellant has sought to amend claims after final rejection. The inclusion of items (3) and (4) in the brief will advise the examiner of what the appellant considers the status of the claims and post-final rejection amendments to be, allowing any disagreement on these questions to be resolved before the appeal is taken up for decision by the Board.

(5) *Summary of Invention.* A concise explanation of the invention defined in the claims involved in the appeal. This explanation is required to refer to the specification by page and line number, and, if there is a drawing, to the drawing by reference characters. Where applicable, it is preferable to read the appealed claims on the specification and any drawing. While reference to page and line number of the specification may require somewhat more detail than simply summarizing the invention, it is considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application.

(6) *Issues.* A concise statement of the issues presented for review. Each stated issue should correspond to a separate ground of rejection which appellant wishes the Board of Patent Appeals and Interferences to review. While the statement of the issues must be concise, it should not be so concise as to omit the basis of each issue. For example, the statement of an issue as "Whether claims 1 and 2 are unpatentable" would not comply with 37 CFR 1.192(c)(6). Rather, the basis of the alleged unpatentability would have to be stated, e.g., "Whether claims 1 and 2 are unpatentable under 35 U.S.C. 103 over Smith in view of Jones," or "Whether claims 1 and 2 are unpatentable under 35 U.S.C. 112, first paragraph, as being based on a nonenabling disclosure." The statement would be limited to the issues presented, and should not include any argument concerning the merits of those issues.

(7) *Grouping of Claims.* For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone, unless a statement is included that the claims of the group do not stand or fall together and, in the argument section of the brief (37 CFR 1.192(c)(8)), appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable. If an appealed ground of rejection applies to more than one claim and appellant considers the rejected claims to be separately patentable, 37 CFR 1.192(c)(7) requires appellant to state that the claims do not stand or fall together, and to present in the appropriate part or parts of the argument under 37 CFR 1.192(c)(8) the reasons why they are considered separately patentable.

The absence of such a statement and argument is a concession by the applicant that, if the ground of rejection were sustained as to any one of the rejected claims, it will be equally applicable to all of them. 37 CFR 1.192(c)(7) is consistent with the practice of the Court of Appeals for the Federal Circuit indicated in such cases as *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991); *In re Nielson*, 816 F.2d 1567, 2 USPQ2d 1525 (Fed. Cir. 1987); *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); and *In re Sernaker*, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983). 37 CFR 1.192(c)(7) requires the inclusion of reasons in order to avoid unsupported assertions of separate patentability. The reasons may be included in the appropriate portion of the "Argument" section of the brief. For example, if claims 1 to 4 are rejected under 35 U.S.C. 102 and appellant considers claim 4 to be separately patentable from claims 1 to 3, he or she should so state in the "Grouping of claims" section of the brief, and then give the reasons for separate patentability in the 35 U.S.C. 102 portion of the "Argument" section (i.e., under 37 CFR 1.192(c)(8)(iii)).

In the absence of a separate statement that the claims do not stand or fall together, the Board panel assigned to the case will normally select the broadest claim in a group and will consider only that claim, even though the group may contain two broad claims, such as "ABCDE" and "ABCDF". The same would be true in a case where there are both broad method and apparatus claims on appeal in the same group. The rationale behind the rule, as amended, is to make the appeal process as efficient as possible. Thus, while the Board will consider each separately argued claim, the work of the Board can be done in a more efficient manner by selecting a single claim from a group of claims when the appellant does not meet the requirements of 37 CFR 1.192(c)(7).

It should be noted that 37 CFR 1.192(c)(7) requires the appellant to perform two affirmative acts in his or her brief in order to have the separate patentability of a plurality of claims subject to the same rejection considered. The appellant must (A) state that the claims do not stand or fall together and (B) present arguments why the claims subject to the same rejection are separately patentable. Where the appellant does neither, the claims will be treated as standing or falling together. Where, however, the appellant (A) omits the statement required by 37 CFR 1.192(c)(7) yet presents arguments in the argument section of the brief, or (B) includes the statement required by 37 CFR 1.192(c)(7) to the effect that one or more claims do not stand or fall together (i.e., that they are separately patentable) yet does not offer argument in support thereof in the "Argument" section of the brief, the appellant should be notified of the noncompliance as per 37 CFR 1.192(d). *Ex parte Schier*, 21 USPQ2d 1016 (Bd. Pat. App. & Int. 1991); *Ex parte Ohsumi*, 21 USPQ2d 1020 (Bd. Pat. App. & Int. 1991).

(8) *Argument*. The appellant's contentions with respect to each of the issues presented for review in 37 CFR 1.192(c)(6), and the basis for those contentions, including citations of authorities, statutes, and parts of the record relied on, should be presented in this section.

Included in this paragraph are five subparagraphs, (i) to (v). Subparagraphs (i) to (iv) concern the grounds of rejection most commonly involved in *ex parte* appeals, namely, 35 U.S.C. 112, first and second paragraphs, 35 U.S.C. 102, and 35 U.S.C. 103. Subparagraph (v) is a general provision concerning grounds of rejection not covered by subparagraphs (i) to (iv).

The purpose of subparagraphs (i) to (iv) is to ensure that the appellant's argument concerning each appealed ground of rejection will include a discussion of the questions relevant to that ground. Compliance with the requirements of the particular subparagraphs which are pertinent to the grounds of rejection involved in an appeal will be beneficial both to the Patent and Trademark Office and appellants. It will not only facilitate a decision by the Board of Patent Appeals and Interferences by enabling the Board to determine more quickly and precisely the appellant's position on the relevant issues, but also will help appellants to focus their arguments on those issues.

For each rejection not falling under subparagraphs (i) to (iv), subparagraph (v) provides that the argument should specify the specific limitations in the rejected claims, if appropriate, or other reasons, which cause the rejection to be in error. This language recognizes that for some grounds of rejection, it may not be necessary to specify particular claim limitations, for example, a rejection under 35 U.S.C. 101, on the ground that the claims are directed to nonstatu-

tory subject matter, as in *Ex parte Hibberd*, 227 USPQ 443 (Bd. Pat. App. & Inter. 1985).

37 CFR 1.192(a) contains the following sentence:

Any argument or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.

This sentence emphasizes that all arguments and authorities which an appellant wishes the Board to consider should be included in the brief. It should be noted that arguments not presented in the brief and made for the first time at the oral hearing are not normally entitled to consideration. *In re Chiddix*, 209 USPQ 78 (Comm'r Pat. 1980); *Rosenblum v. Hiroshima*, 220 USPQ 383 (Comm'r Pat. 1983).

37 CFR 1.192(a) is not intended to preclude the filing of a supplemental paper if new authority should become available or relevant after the brief was filed. An example of such circumstances would be where a pertinent decision of a court or other tribunal was not published until after the brief was filed.

(9) *Appendix*. An appendix containing a copy of the claims involved in the appeal.

The copy of the claims required in the brief Appendix by 37 CFR 1.192(c)(9) should be a clean copy and should not include any brackets or underlining as required by 37 CFR 1.121(a)(2). See MPEP § 1454 for the presentation of the copy of the claims in a reissue application.

For sake of convenience, the copy of the claims involved should be double spaced and the appendix should start on a new page.

37 CFR 1.192(c) merely specifies the minimum requirements for a brief, and does not prohibit the inclusion of any other material which an appellant may consider necessary or desirable, for example, a list of references, table of contents, table of cases, etc. A brief is in compliance with 37 CFR 1.192(c) as long as it includes items (1) to (9) in the order set forth (with the appendix, item (9), at the end).

REVIEW OF BRIEF BY EXAMINER

The question of whether a brief complies with the rule is a matter within the jurisdiction of the examiner. 37 CFR 1.192(d) provides that if a brief is filed which does not comply with all the requirements of paragraph (c), the appellant will be notified of the reasons for noncompliance. Appellant will be given the longest of any of the following time periods to correct the defect(s):

(A) 1 month or 30 days from the mailing of the notification of non-compliance, whichever is longer;

(B) within the time period for reply to the action from which appeal has been taken; or

(C) within 2 months from the date of the notice of appeal under 37 CFR 1.191.

Extensions of time may be granted under 37 CFR 1.136(a) or 1.136(b). The examiner may use the form paragraphs set forth below or form PTOL-462, "Notification of Non-Compliance with 37 CFR 1.192(c)," to notify appellant that the appeal brief is defective. The appeal will be dismissed if the appellant does not timely file an amended brief, or files an amended brief which does not overcome all the reasons for noncompliance of which the appellant was notified.

Under 37 CFR 1.192(d), the appellant may file an amended brief to correct any deficiencies in the original brief. Moreover, if appellant disagrees with the examiner's holding of noncompliance, a petition under 37 CFR 1.181 may be filed.

Once the brief has been filed, a petition to suspend proceedings may be considered on its merits, but will be granted only in exceptional cases, such as where the writing of the examiner's answer would be fruitless or the proceedings would work an unusual hardship on the appellant.

For a reply brief, see MPEP § 1208.03.

Form paragraphs 12.08-12.13, 12.16, 12.17, and 12.69-12.78, or Form PTOL-462, "Notification of Non-Compliance with 37 CFR 1.192(c)," may be used concerning the appeal brief.

¶ 12.08 Appeal Dismissed - Brief Fee Unpaid, No Allowed Claims

The appeal under 37 CFR 1.191 is dismissed because the fee for filing the brief, as required under 37 CFR 1.17(c) was not submitted or timely submitted and the period for obtaining an extension of time to file the brief under 37 CFR 1.136(a) has expired.

As a result of this dismissal, the application is ABANDONED since there are no allowed claims.

Examiner Note:

Claims which have been indicated as containing allowable subject matter, but are objected to as being dependent upon a rejected claim, are to be considered as if they were rejected. See MPEP § 1215.04.

¶ 12.09 Appeal Dismissed - Brief Fee Unpaid, Allowed Claims

The appeal under 37 CFR 1.191 is dismissed because the fee for filing the appeal brief, as required under 37 CFR 1.17(c), was not submitted or timely submitted and the period for obtaining an extension of time to file the brief under 37 CFR 1.136(a) has expired.

As a result of this dismissal, the application will be further processed by the examiner since it contains allowed claims. Prosecution on the merits remains CLOSED.

Examiner Note:

Claims which have been indicated as containing allowable subject matter, but are objected to as being dependent upon a rejected claim, are to be considered as if they were rejected. See MPEP § 1215.04.

¶ 12.09.01 Appeal Dismissed - Allowed Claims, Formal Matters Remaining

In view of applicant's failure to file a brief within the time prescribed by 37 CFR 1.192(a), the appeal stands dismissed and the proceedings as to the rejected claims are considered terminated. See 37 CFR 1.197(c).

This application will be passed to issue on allowed claim [1] provided the following formal matters are corrected. Prosecution is otherwise closed.

[2]

Applicant is required to make the necessary corrections within a shortened statutory period set to expire ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing date of this letter. Extensions of time may be granted under 37 CFR 1.136.

Examiner Note:

1. This paragraph should only be used if the formal matters cannot be handled by examiner's amendment. See MPEP § 1215.04.
2. In bracket 2, insert a description of the formal matters to be corrected.
3. Claims which have been indicated as containing allowable subject matter but are objected to as being dependent upon a rejected claim are to be considered as if they were rejected. See MPEP § 1215.04.

¶ 12.10 Extension To File Brief - Granted

The request for an extension of time under 37 CFR 1.136(b) for filing the appeal brief under 37 CFR 1.192 filed on [1] has been approved for [2].

Examiner Note:

This paragraph should only be used when 37 CFR 1.136(a) is not available or has been exhausted, such as in litigation reissues.

¶ 12.11 Extension To File Brief - Denied

The request for an extension of time under 37 CFR 1.136(b) for filing the appeal brief under 37 CFR 1.192 filed on [1] has been disapproved because no sufficient cause for the extension has been shown.

Examiner Note:

This paragraph should only be used when 37 CFR 1.136(a) is not available or has been exhausted, such as in litigation reissues.

¶ 12.12 Brief Defective - Unsigned

The appeal brief filed on [1] is defective because it is unsigned. 37 CFR 1.33. A ratification properly signed is required.

To avoid dismissal of the appeal, appellant must ratify the appeal brief within the longest of any of the following TIME PERIODS: (1) ONE MONTH or THIRTY DAYS from the mailing of this communication, whichever is longer; (2) within the time period for reply to the action from which appeal has been taken; or (3) within two months from the date of the notice of appeal under 37 CFR 1.191. Extensions of these time periods may be granted under 37 CFR 1.136.

¶ 12.13 Brief Defective - Three Copies Lacking

The appeal brief filed on [1] is defective because the three copies of the Brief required under 37 CFR 1.192(a) have not been submitted.

To avoid dismissal of the appeal, appellant must submit the necessary additional copies of the appeal brief within the longest of any of the following TIME PERIODS: (1) ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing of this communication; (2) within the time period for reply to the action from which appeal has been taken; or, (3) within two months from the date of the notice of appeal under 37 CFR 1.191. Extensions of these time periods may be granted under 37 CFR 1.136.

¶ 12.16 Brief Unacceptable - Fee Unpaid

The appeal brief filed on [1] is unacceptable because the fee required under 37 CFR 1.17(c) was not timely filed.

This application will become abandoned unless appellant obtains an extension of time under 37 CFR 1.136(a) and files the required appeal brief fee. The date on which the brief, the fee for filing the brief, the peti-

tion under 37 CFR 1.136(a), and the petition fee under 37 CFR 1.17(a) are filed will be the date of the reply and also the date for determining the period of extension and the corresponding amount of the fee. In no case may an appellant obtain an extension for more than FIVE MONTHS under 37 CFR 1.136(a) beyond the TWO MONTH period for filing the appeal brief.

¶ 12.17 Brief Unacceptable - Not Timely Filed

The appeal brief filed on [1] is unacceptable because it was filed after the expiration of the required period for reply.

This application will become abandoned unless appellant obtains an extension of time under 37 CFR 1.136(a). The date on which the appeal brief, the fee for filing the brief, the petition under 37 CFR 1.136(a), and the petition fee under 37 CFR 1.17(a) are filed will be the date of the reply and also the date for determining the period of extension and the corresponding amount of the fee. In no case may an appellant obtain an extension for more than FIVE MONTHS under 37 CFR 1.136(a) beyond the TWO MONTH period for filing the appeal brief.

Form paragraph 12.69, followed by one or more of from paragraphs 12.69.01-12.78 may be used for noting non-compliance with 37 CFR 1.192(c)

¶ 12.69 Heading for Notice Under 37 CFR 1.192(c)

NOTIFICATION OF NON-COMPLIANCE WITH THE REQUIREMENTS OF 37 CFR 1.192(c)

Examiner Note:

Use form PTOL-90 and follow with one or more of form paragraphs 12.69.01 to 12.77 and conclude with paragraph 12.78.

¶ 12.69.01 Statement in Brief That Claims Do Not Stand or Fall Together - Supporting Reasons Lacking

The brief includes a statement that claims [1] do not stand or fall together, but fails to present reasons in support thereof as required under 37 CFR 1.192(c)(7). MPEP § 1206.

Examiner Note:

1. This paragraph should be used only when no supporting reasons are presented in the brief. If reasons are presented, even if they are not agreed with, use form paragraph 12.55.02 instead of this form paragraph. Reasons for disagreement are discussed in either the "Grounds of Rejection" or in the "Response to Argument" portion of the Examiner's Answer.
2. If the brief contains neither a statement that claims do not stand or fall together nor reasons in support thereof, use paragraph 12.55.01 in the Examiner's Answer.

¶ 12.70 Missing Section Headings

The brief does not contain the items of the brief required by 37 CFR 1.192(c) under the appropriate headings and/or in the order indicated. [1]

Examiner Note:

In bracket 1, insert an indication of the missing headings or errors in the order of items.

¶ 12.70.01 Defect in Statement of Real Party in Interest

The brief does not contain a heading identifying the real party in interest as required by 37 CFR 1.192(c)(1).

¶ 12.70.02 Defect in Statement of Related Appeals and Interferences

The brief does not contain a heading identifying the related appeals and interferences directly affected by or having a bearing on the decision in the pending appeal as required by 37 CFR 1.192(c)(2).

¶ 12.71 Defect in Statement of Status of Claims

The brief does not contain a statement of the status of all the claims, pending or canceled, and identify the claims appealed as required by 37 CFR 1.192(c)(3). [1]

Examiner Note:

In bracket 1, insert an indication of the missing claim status information.

¶ 12.72 Defect in Statement of Status of Amendment Filed After Final Rejection

The brief does not contain a statement of the status of an amendment filed subsequent to the final rejection as required by 37 CFR 1.192(c)(4). [1]

Examiner Note:

In bracket 1, insert an identification of the amendment for which the status is missing.

¶ 12.73 Defect in Explanation of the Invention

The brief does not contain a concise explanation of the invention defined in the claims involved in the appeal, which refers to the specification by page and line number, and to the drawing, if any, by reference characters as required by 37 CFR 1.192(c)(5). [1]

Examiner Note:

In bracket 1, insert an indication of the missing explanation.

¶ 12.74 Defect in Statement of the Issues

The brief does not contain a concise statement of the issues presented for review as required by 37 CFR 1.192(c)(6). [1]

Examiner Note:

In bracket 1, insert an indication of the missing concise statement of the issues presented for review.

¶ 12.76 Defect in the Arguments of the Appellant

The brief does not contain arguments of the appellant with respect to each of the issues presented for review in 37 CFR 1.192(c)(6), and the basis therefor, with citations of the authorities, statutes, and parts of the record relied on as required by 37 CFR 1.192(c)(8).

Examiner Note:

Include one or more of form paragraphs 12.76.01 to 12.76.06 which apply.

¶ 12.76.01 Separate Heading for Each Issue

Each issue should be treated under a separate heading.

¶ 12.76.02 Defect in 112, First Paragraph, Rejection Argument

The brief does not contain, for each rejection under 35 U.S.C. 112 (first paragraph), an argument which specifies the errors in the rejection and how the first paragraph of 35 U.S.C. 112 is complied with, including how the specification and drawings, if any, [1].

Examiner Note:

In bracket 1, insert the following wording, as appropriate:

- (a)--describe the subject matter defined by each of the rejected claims--;
- (b)--enable any person skilled in the art to make and use the subject matter defined by each of the rejected claims--; or
- (c)--set forth the best mode contemplated by the inventor of carrying out his/her invention--.

¶ 12.76.03 *Defect in 112, Second Paragraph, Rejection Argument*

The brief does not contain, for each rejection under 35 U.S.C. 112 (second paragraph), an argument which specifies the errors in the rejection and how the claims particularly point out and distinctly claim the subject matter which applicant regards as the invention.

¶ 12.76.04 *Defect in 102 Rejection Argument*

The brief does not contain, for each rejection under 35 U.S.C. 102, an argument which specifies the errors in the rejection and why the rejected claims are patentable under 35 U.S.C. 102, including any specific limitations in the rejected claims which are not described in the prior art relied upon in the rejection.

Examiner Note:

Specify claim(s) for which no argument of error was specified.

¶ 12.76.05 *Defect in 103 Rejection Argument*

The brief does not contain, for each rejection under 35 U.S.C. 103, an argument which specifies the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied upon in the rejection, and an explanation how such limitations render the claimed subject matter unobvious over the prior art. If the rejection is based upon a combination of references, the argument must explain why the references, taken as a whole do not suggest the claimed subject matter, and shall include, as may be appropriate, an explanation of why features disclosed in one reference may not be properly combined with features disclosed in another reference. A general argument that all the limitations are not described in a single reference does not satisfy the requirements of 37 CFR 1.192(c)(8)(iv).

Examiner Note:

Specify claim(s) for which no argument of error was specified.

¶ 12.76.06 *For Any Rejection Other Than Those Referred to in Paragraphs (c)(8)(i) to (iv) of 37 CFR 1.192 for Which No Argument or Error Was Specified*

The brief does not contain an argument which specifies the errors in the rejection and the specific limitations in the rejected claims, if appropriate, or other reasons, which cause the rejection to be in error.

Examiner Note:

Specify claim(s) for which for which no argument of error was specified.

¶ 12.77 *No Copy of Appealed Claims in Appendix*

The brief does not contain a copy of the claims involved in the appeal in the Appendix.

¶ 12.78 *Period For Response Under 37 CFR 1.192(d)*

Appellant is required to comply with provisions of 37 CFR 1.192(c). To avoid dismissal of the appeal, Appellant must comply with the provisions of 37 CFR 1.192(c) within the longest of any of the following TIME PERIODS: (1) ONE MONTH or THIRTY DAYS, whichever is longer, from the mailing of this communication; (2) within the time period for reply to the action from which appeal has been taken; or (3) within two months from the date of the notice of appeal under 37 CFR 1.191. Extensions of these time periods may be granted under 37 CFR 1.136.

Examiner Note:

This paragraph has limited application. To notify applicant of non-compliance with 37 CFR 1.192(c) examiner must use form PTOL-462.

1207 Amendment Filed With or After Appeal

To expedite the resolution of cases under final rejection, an amendment filed at any time after final rejection, but before jurisdiction has passed to the Board (see MPEP § 1210), may be entered upon or after filing of an appeal brief provided that the amendment conforms to the requirements of 37 CFR 1.116. For example, if the amendment necessitates a new search, raises the issue of new matter, presents additional claims without cancelling a corresponding number of finally rejected claims, or otherwise introduces new issues, it will not be entered. A new amendment, new affidavit, or other new evidence must be submitted in a paper separate from the appeal brief. Entry of a new amendment, new affidavit, or other new evidence in an application on appeal is not a matter of right. The entry of an amendment (which may or may not include a new affidavit, declaration, or exhibit) submitted in an application on appeal continues to be governed by 37 CFR 1.116, and the entry of a new affidavit or other new evidence in an application on appeal is governed by 37 CFR 1.195. Examiners must respond to all nonentered amendments after final rejection, and indicate the status of each claim of record or proposed, including the designation of claims that would be entered on the filing of an appeal if filed in a separate paper. If the examiner indicates (in the advisory action) that a proposed amendment of the claim(s) would be entered for purposes of appeal, it is imperative for the examiner to also state (in the same advisory action) how the individual rejection(s) set forth in the final Office action will be used to reject the added or amended claim(s) in the examiner's answer. See 37 CFR 1.193(a)(2) and MPEP § 1208.01. Except where an amendment merely cancels claims and/or adopts examiner suggestions, removes issues from appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under 37 CFR 1.116 will be expected of all amendments after final rejection.

If, after appeal has been taken, a paper is presented which *on its face* clearly places the application in condition for allowance, such paper should be entered and a Notice of Allowability form PTOL-37 promptly sent to applicant.

In accordance with the above, the brief must be directed to the claims and to the record of the case as they appeared at the time of the appeal, but it may, of course, withdraw from consideration on appeal any claims or issues as desired by appellant. Even if the appeal brief withdraws from consideration any claims or issues (i.e., appellant acquiesces to any rejection), the examiner must continue to make the rejection in the examiner's answer, unless an amendment obviating the rejection has been previously proposed and entered.

A timely filed brief will be referred to the examiner for consideration of its propriety as to the appeal issues and for preparation of an examiner's answer if the brief is proper and the application is not allowable. The examiner's answer may withdraw the rejection of claims, if appropriate. The examiner may also determine that it is necessary to reopen prosecution to enter a new ground of rejection. Note MPEP § 1208.02. No new ground of rejection, however, is permitted in an examiner's answer. 37 CFR 1.193(a)(2). See MPEP § 714.13 for procedure on handling amendments filed after final action and before appeal.

An amendment received after jurisdiction has passed to the Board should not be considered by the examiner unless remanded by the Board for such purpose. See MPEP § 1210 and § 1211.01.

Note that 37 CFR 1.192(c)(4) requires a statement as to the status of any amendment filed subsequent to the final rejection. See also MPEP § 1206.

1208 Examiner's Answer

37 CFR 1.193. Examiner's answer and reply brief.

(a)(1) The primary examiner may, within such time as may be directed by the Commissioner, furnish a written statement in answer to appellant's brief including such explanation of the invention claimed and of the references and grounds of rejection as may be necessary, supplying a copy to appellant. If the primary examiner finds that the appeal is not regular in form or does not relate to an appealable action, the primary examiner shall so state.

(2) An examiner's answer must not include a new ground of rejection, but if an amendment under § 1.116 proposes to add or amend one or more claims and appellant was advised that the amendment under § 1.116 would be entered for purposes of appeal and which individual rejection(s) set forth in the action from which the appeal was taken would be used to reject the added or amended claim(s), then the appeal brief must address the rejection(s) of the claim(s) added or amended by the amendment under § 1.116 as appellant was so advised and the examiner's answer may include the rejection(s) of the claim(s) added or amended by the amendment under § 1.116 as appellant was so advised. The filing of an amendment under § 1.116 which is entered for purposes of appeal represents appellant's consent that when so advised any appeal proceed on those claim(s) added or amended by the amendment under § 1.116 subject to any rejection set forth in the action from which the appeal was taken.

(b)(1) Appellant may file a reply brief to an examiner's answer within two months from the date of such examiner's answer. See § 1.136(b) for extensions of time for filing a reply brief in a patent application and § 1.550(c) for extensions of time for filing a reply brief in a reexamination proceeding. The primary examiner must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief. A supplemental examiner's answer is not permitted, unless the application has been remanded by the Board of Patent Appeals and Interferences for such purpose.

(2) Where prosecution is reopened by the primary examiner after an appeal or reply brief has been filed, appellant must exercise one of the following two options to avoid abandonment of the application:

- (i) File a reply under § 1.111, if the Office action is not final, or a reply under § 1.113, if the Office action is final; or
- (ii) Request reinstatement of the appeal. If reinstatement of the appeal is requested, such request must be accompanied by a supple-

mental appeal brief, but no new amendments, affidavits (§§ 1.130, 1.131 or 1.132) or other evidence are permitted.

APPEAL CONFERENCE

Appealed cases in which the brief has been filed may be reviewed by conference in the group, in a manner deemed appropriate by the Group Director. For example, those participating in the conference may include (1) a primary examiner, (2) the examiner charged with preparation of the examiner's answer, and (3) another examiner, known as the conferee, having sufficient experience to be of assistance in the consideration of the merits of the issues on appeal.

The Group Director has the discretion as to whether or not appeal conferences are necessary in the examining group and, if so, in which instances they are to be held. If an appeal conference is held, the Supervisory Patent Examiner should be informed thereof.

If a conference is held, the primary examiner responsible for signing the examiner's answer should weigh the arguments of the other examiners. If it is determined that the rejection(s) should be maintained, the examiner will then prepare his or her examiner's answer. During the conference, consideration should be given to the possibility of dropping cumulative art rejections and eliminating technical rejections of doubtful value.

On the examiner's answer, the third person (conferee) should place his or her initials below those of the examiner who prepared the answer, thus: ABC (conf.). This does not indicate, necessarily, concurrence with the position taken in the answer.

If the examiner charged with the responsibility of preparing the answer reaches the conclusion that the appeal should not be forwarded and the primary examiner approves, no conference is held.

Before preparing the answer, the examiner should make certain that all amendments approved for entry have in fact been physically entered. The Clerk of the Board will return to the group any application in which approved amendments have not been entered.

ANSWER

The examiner should furnish the appellant with a written statement in answer to the appellant's brief within 2 months after the receipt of the brief by the examiner.

The answer should contain a response to the allegations or arguments in the brief and should call attention to any errors in appellant's copy of the claims. If any rejection is withdrawn, the withdrawal should be clearly stated in the examiner's answer under "Issues." Grounds of rejection not argued in the examiner's answer are usually treated as having been dropped, but may be considered by the Board if it desires to do so. The examiner should treat affidavits, dec-

larations, or exhibits filed with or after the notice of appeal in accordance with 37 CFR 1.195. If an affidavit, declaration, or exhibit was refused entry under 37 CFR 1.195, the examiner should not comment on it in the examiner's answer. Likewise, it would be improper for appellant to rely on an affidavit, declaration, or exhibit, which was refused entry, in an appeal brief. If appellant has grounds for challenging the non-entry of an affidavit, declaration, or exhibit, he or she should file a timely petition seeking supervisory review of the non-entry. Any affidavits or declarations in the file swearing behind a patent should be clearly identified by the examiner as being considered under either 37 CFR 1.131 or 37 CFR 1.608(b).

If the brief fails to address any or all grounds of rejection advanced by the examiner, or comply with 37 CFR 1.192(c), the indicated procedure for handling such briefs set forth in MPEP § 1206 under "Review of Brief by Examiner" should be followed.

Because of the practice of the Patent and Trademark Office in entering amendments after final action under justifiable circumstances for purposes of appeal, many cases coming before the Board for consideration contain claims which are not the claims treated in the examiner's final rejection. They are either entirely new claims or amended versions of the finally rejected claims or both. Where an amendment under 37 CFR 1.116 would be entered for appeal purposes, the examiner must identify (in an advisory action) how one or more individual rejections set forth in the final rejection would be used to reject the added or amended claim(s). See 37 CFR 1.193(a)(2) and MPEP § 1208.01. It is important to note that if more than a mere reference to one or more individual rejections set forth in the final rejection is necessary to explain how the added or amended claims would be rejected, then the amendment should not be entered because it raises new issues requiring further consideration and/or search. Furthermore, the mere fact that an amendment under 37 CFR 1.116 could fall within the operation of 37 CFR 1.193(a)(2) does not mean that the amendment must be entered by the examiner. That is, the provisions of 37 CFR 1.116 (and not 37 CFR 1.193(a)(2)) control as to whether an amendment under 37 CFR 1.116 is entitled to entry.

It also frequently happens that an examiner will state a position in the answer in a manner that represents a shift from the position stated in the final rejection without indicating that the last stated position supersedes the former. Such a situation confuses the issue and likewise poses difficulties for the Board since it is not clear exactly what the examiner's ultimate position is.

If there is a complete and thorough development of the issues at the time of final rejection, it is possible to save

time in preparing the examiner's answer required by 37 CFR 1.193 by taking any of the following steps:

(A) Examiners may incorporate in the answer their statement of the grounds of rejection merely by reference to the final rejection (or a single other action on which it is based, MPEP § 706.07). Only those statements of grounds of rejection appearing in a *single* prior action may be incorporated by reference. An examiner's answer should not refer, either directly or indirectly, to more than one prior Office action. Statements of grounds of rejection appearing in actions other than the aforementioned single prior action should be *quoted* in the answer. The page and paragraph of the final action or other single prior action which it is desired to incorporate by reference should be explicitly identified. Of course, if the examiner feels that some further explanation of the rejection is necessary, he or she should include it in the answer but ordinarily he or she may avoid another recital of the issues and another elaboration of the grounds of rejection. The answer should also include any necessary rebuttal of arguments presented in the appellant's brief if the final action does not adequately meet the arguments.

(B) If the appellant fails to describe the invention, as required by 37 CFR 1.192, the examiner is not required to provide these omissions under 37 CFR 1.192(d). The examiner should, however, clarify the description and explanation in the answer if he or she feels it necessary to present properly and effectively his or her case to the Board.

The examiner should reevaluate his or her position in the light of the arguments presented in the brief, and should expressly withdraw any rejections not adhered to, especially if the rejection was made in an action which is incorporated by reference. This should be done even though any rejection not repeated and discussed in the answer may be taken by the Board as having been withdrawn. *Ex parte Emm*, 118 USPQ 180 (Bd. App. 1957).

A new ground of rejection is no longer permitted in an examiner's answer. For a discussion of what constitutes a new ground of rejection, see MPEP § 1208.01. If a new ground of rejection is necessary, prosecution must be reopened. The examiner must obtain approval from the Supervisory Patent Examiner prior to reopening prosecution after an appeal. See MPEP § 1002.02(d).

All correspondence with the Board, whether by the examiner or the appellant, must be on the record. No unpublished decisions which are unavailable to the general public by reason of 35 U.S.C. 122 can be cited by the examiner or the appellant except that either the examiner or the appellant has the right to cite an unpublished decision in